



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/200,430	11/27/1998	KAORU YAMAMOTO	041465-5053-01	4823

55694 7590 04/03/2006

DRINKER BIDDLE & REATH (DC)
1500 K STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005-1209

EXAMINER

ONUAKU, CHRISTOPHER O

ART UNIT	PAPER NUMBER
----------	--------------

2621

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/200,430

Applicant(s)

YAMAMOTO ET AL.

Examiner

Christopher Onuaku

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-17 and 20-23 is/are allowed.
- 6) ☒ Claim(s) 1-5, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/21/05 have been fully considered but they are not persuasive.

Applicant argues, with respect to claims 1-5,18&19 rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter, that the recording medium recited in claim 1 includes the first reproduction control information in the video zone and the second reproduction control information in the audio zone, and that, therefore, a video DVD player can reproduce the audio and video information out of the substantial information recorded on the claimed DVD in accordance with the first reproduction control information, and an audio DVD player can reproduce only the audio information out of the substantial information recorded on the claimed DVD in accordance with the second reproduction control information. And, that, therefore, the material is structurally and functionally interrelated to the information recording medium, and the material is not merely carried by the medium.

In response, in the preamble of claim 1, the applicant claims a AVD information recording medium, and this recording medium includes audio zone and video zone. In the body of the claim, applicant claims, for example, "... first reproduction control information to reproduce the video information ..." , and " ... second reproduction control information to reproduce only the audio information ... ". The claimed first and

second control information as cited fail to actually perform the function(s) of reproducing the video and/or audio information. Note that the claimed first and second reproduction control information, the first and second management information, for example, are merely signals recorded on the recording medium, and these signals may be used to control external apparatuses to perform given functions. The apparatuses are clearly not parts of the recording medium. Furthermore, the preamble of the claim (claim 1) which sets forth a DVD information recording medium fails to provide any connection to the body of the claim (claim 1).

The applicant's arguments are not persuasive and, therefore, not acceptable. The 101 rejections of the claims are maintained.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-5, 18 & 19 are rejected under 35 U.S.C. 101 because the claims are non-statutory descriptive material recorded on recording medium; the material is not structurally and functionally interrelated to the medium but is merely carried by the medium. For example, the preamble of the claim fails to set up a tangible functional relationship with the body of the claim wherein a function is actually performed/executed. The mere indication of a function that can be performed/executed by a device is non-functional; the claim must clearly cite a function that is actually executed by the claimed invention. Merely claiming non-functional descriptive material

Art Unit: 2616

stored in a recording medium does not make the claim statutory. See MPEP Section 2106.IV.B.1.

Allowable Subject Matter

4. Claims 6-17&20-23 are allowable over the prior art of record.
5. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 6, the invention relates to information record medium on which video information is recorded such as a video DVD and which allows an audio DVD compatible player to reproduce only the audio information therefrom without discrepancy, and an apparatus for and a method of appropriately reproducing the audio information from the video DVD.

The closest reference Heo (US 6,741,796) discloses a digital versatile disk (DVD), and an apparatus and method for playing the DVD, including an audio DVD (DVD-Audio) and an apparatus and method for playing the same

However, Heo fails to explicitly disclose an information reproducing apparatus for reproducing a DVD information record medium having an audio zone and the video zone, where the information reproducing apparatus for reproducing a DVD information record medium further comprises second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproducing apparatus that is able to reproduce audio, but is not able to reproduce video

Regarding claim 7, the invention relates to an information record medium on which video information is recorded such as a video DVD and which allows an audio DVD compatible player to reproduce only the audio information therefrom without discrepancy, and an apparatus for and a method of appropriately reproducing the audio information from the video DVD.

The closest reference Heo (US 6,741,796) discloses a digital versatile disk (DVD), and an apparatus and method for playing the DVD, including an audio DVD (DVD-Audio) and an apparatus and method for playing the same.

However, Heo fails to explicitly disclose an information reproducing apparatus for reproducing a DVD information record medium having an audio zone and the video zone, where the information reproducing apparatus for reproducing a DVD information record medium further comprises second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproducing apparatus that is able to reproduce audio, but is not able to reproduce video

Regarding claim 8, the invention relates to an information record medium medium on which video information is recorded such as a video DVD and which allows an audio DVD compatible player to reproduce only the audio information therefrom without discrepancy, and an apparatus for and a method of appropriately reproducing the audio information from the video DVD.

The closest reference Heo (US 6,741,796) discloses a digital versatile disk (DVD), and an apparatus and method for playing the DVD, including an audio DVD (DVD-Audio) and an apparatus and method for playing the same.

However, Heo fails to explicitly disclose an information reproducing apparatus for reproducing a DVD information record medium having an audio zone and the video zone, where the information reproducing apparatus for reproducing a DVD information record medium further comprises second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproducing apparatus that is able to reproduce audio, but is not able to reproduce video

Regarding claim 9, the invention relates to an information record medium medium on which video information is recorded such as a video DVD and which allows an audio DVD compatible player to reproduce only the audio information therefrom without discrepancy, and an apparatus for and a method of appropriately reproducing the audio information from the video DVD.

The closest reference Heo (US 6,741,796) discloses a digital versatile disk (DVD), and an apparatus and method for playing the DVD, including an audio DVD (DVD-Audio) and an apparatus and method for playing the same.

However, Heo fails to explicitly disclose an information reproducing apparatus for reproducing a DVD information record medium having an audio zone and the video zone, where the information reproducing apparatus for reproducing a DVD information

Art Unit: 2616

record medium further comprises second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproducing apparatus that is able to reproduce audio, but is not able to reproduce video

Regarding claim 10, the invention relates to an information record medium medium on which video information is recorded such as a video DVD and which allows an audio DVD compatible player to reproduce only the audio information thereforom without discrepancy, and an apparatus for and a method of appropriately reproducing the audio information from the video DVD.

The closest reference Heo (US 6,741,796) discloses a digital versatile disk (DVD), and an apparatus and method for playing the DVD, including an audio DVD (DVD-Audio) and an apparatus and method for playing the same.

However, Heo fails to explicitly disclose an information reproducing apparatus for reproducing a DVD information record medium having an audio zone and the video zone, where the information reproducing apparatus for reproducing a DVD information record medium further comprises second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproducing apparatus that is able to reproduce audio, but is not able to reproduce video

Regarding claim 11, the invention relates to an information record medium medium on which video information is recorded such as a video DVD and which allows an audio DVD compatible player to reproduce only the audio information thereforom without discrepancy, and an apparatus for and a method of appropriately reproducing the audio information from the video DVD.

The closest reference Heo (US 6,741,796) discloses a digital versatile disk (DVD), and an apparatus and method for playing the DVD, including an audio DVD (DVD-Audio) and an apparatus and method for playing the same.

However, Heo fails to explicitly disclose an information reproducing apparatus for reproducing a DVD information record medium having an audio zone and the video zone, where the information reproducing apparatus for reproducing a DVD information record medium further comprises second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproducing apparatus that is able to reproduce audio, but is not able to reproduce video

Regarding claim 20, the invention relates to an information record medium medium on which video information is recorded such as a video DVD and which allows an audio DVD compatible player to reproduce only the audio information thereforom without discrepancy, and an apparatus for and a method of appropriately reproducing the audio information from the video DVD.

The closest reference Heo (US 6,741,796) discloses a digital versatile disk (DVD), and an apparatus and method for playing the DVD, including an audio DVD (DVD-Audio) and an apparatus and method for playing the same.

However, Heo fails to explicitly disclose an information reproducing apparatus for reproducing a DVD information record medium having an audio zone and the video zone, where the information reproducing apparatus for reproducing a DVD information record medium further comprises second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproducing apparatus that is able to reproduce audio, but is not able to reproduce video

Regarding claim 21, the invention relates to an information record medium medium on which video information is recorded such as a video DVD and which allows an audio DVD compatible player to reproduce only the audio information therefrom without discrepancy, and an apparatus for and a method of appropriately reproducing the audio information from the video DVD.

The closest reference Heo (US 6,741,796) discloses a digital versatile disk (DVD), and an apparatus and method for playing the DVD, including an audio DVD (DVD-Audio) and an apparatus and method for playing the same.

However, Heo fails to explicitly disclose an information reproducing apparatus for reproducing a DVD information record medium having an audio zone and the video zone, where the information reproducing apparatus for reproducing a DVD information

Art Unit: 2616

record medium further comprises second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproducing apparatus that is able to reproduce audio, but is not able to reproduce video.

Regarding claim 22, the invention relates to an information record medium medium on which video information is recorded such as a video DVD and which allows an audio DVD compatible player to reproduce only the audio information thereforom without discrepancy, and an apparatus for and a method of appropriately reproducing the audio information from the video DVD.

The closest reference Heo (US 6,741,796) discloses a digital versatile disk (DVD), and an apparatus and method for playing the DVD, including an audio DVD (DVD-Audio) and an apparatus and method for playing the same.

However, Heo fails to explicitly disclose an information reproducing apparatus for reproducing a DVD information record medium having an audio zone and the video zone, where the information reproducing apparatus for reproducing a DVD information record medium further comprises second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproducing apparatus that is able to reproduce audio, but is not able to reproduce video

Regarding claim 23, the invention relates to an information record medium medium on which video information is recorded such as a video DVD and which allows an audio DVD compatible player to reproduce only the audio information thereforom without discrepancy, and an apparatus for and a method of appropriately reproducing the audio information from the video DVD.

The closest reference Heo (US 6,741,796) discloses a digital versatile disk (DVD), and an apparatus and method for playing the DVD, including an audio DVD (DVD-Audio) and an apparatus and method for playing the same.

However, Heo fails to explicitly disclose an information reproducing apparatus for reproducing a DVD information record medium having an audio zone and the video zone, where the information reproducing apparatus for reproducing a DVD information record medium further comprises second reproduction control information to reproduce only the audio information out of the substantial information only for a second reproducing apparatus that is able to reproduce audio, but is not able to reproduce video.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 2616

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Onuaku whose telephone number is 571-272-7379. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


COO

3/3/06


James J. Groody
Supervisory Patent Examiner
Art Unit 262